

Translation

PATENT COOPERATION TREATY

PCT/AT2003/000324



PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference R 42519	FOR FURTHER ACTION See Form PCT/IPEA/416	
International application No. PCT/AT2003/000324	International filing date (day/month/year) 30 October 2003 (30.10.2003)	Priority date (day/month/year) 31 October 2002 (31.10.2002)
International Patent Classification (IPC) or national classification and IPC C12M 1/16		
Applicant ORIDIS BIOMED FORSCHUNGS- UND ENTWICKLUNGS GMBH		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising:
 - a. ☐ (sent to the applicant and to the International Bureau) a total of _____ sheets, as follows:
 - ☐ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
 - ☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.
 - b. ☐ (sent to the International Bureau only) a total of _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:
- | | |
|---|---|
| <input checked="" type="checkbox"/> Box No. I | Basis of the report |
| <input type="checkbox"/> Box No. II | Priority |
| <input type="checkbox"/> Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI | Certain documents cited |
| <input type="checkbox"/> Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> Box No. VIII | Certain observations on the international application |

Date of submission of the demand 24 May 2004 (24.05.2004)	Date of completion of this report 09 February 2005 (09.02.2005)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

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Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This report is based on translations from the original language into the following language _____, which is language of a translation furnished for the purpose of:
- ☐ international search (under Rules 12.3 and 23.1(b))
- ☐ publication of the international application (under Rule 12.4)
- ☐ international preliminary examination (under Rules 55.2 and/or 55.3)

2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

- ☒ The international application as originally filed/furnished
- ☒ the description:
- pages _____ 1-13 _____, as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☒ the claims:
- pages _____ 1-43 _____, as originally filed/furnished
- pages* _____, as amended (together with any statement) under Article 19
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☒ the drawings:
- pages _____ 1/4-4/4 _____, as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

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V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-43	YES
	Claims		NO
Inventive step (IS)	Claims	1-43	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-43	YES
	Claims		NO

2. Citations and explanations

1. Reference is made to the following documents:

- D1: US-A-6 103 518 (S.B. LEIGHTON) 15 August 2000
D2: WO 99/15875 A (MACQUARIE RESEARCH LTD) 1 April 1999
D3: DE 101 19 461 A (UFZ-UMWELTFORSCHUNGSZENTRUM LEIPZIG-HALLE) 31 October 2002

The document (D3) designated as a P-document in the search report must be taken into account as prior art according to PCT Rule 64.1 if the claimed priority date of the present application is accepted.

2. The subject matter of claim 1 involves an inventive step (PCT Article 33(3)).

D1 (figure 1; column 10, line 16 - column 13, line 52; claims), which is considered the closest prior art, discloses a method and the device for manipulating tissue samples in which holes are punched in the sample carriers using a needle and tissue samples are punched out of prepared tissue portions using a further needle, and the tissue samples are introduced into the holes that have been

punched in the sample carriers. The subject matter of claim 1 differs from D1 in that at least one digital microscopic image of a section of a preparation is overlaid with an image of the surface of this preparation and in that markings are applied to the overlaid image which define the desired positions at which the samples are automatically punched out and introduced into the holes in the sample carriers. The invention addresses the problem of providing a method for manipulating samples which enables the desired positions to be exchanged as rapidly as possible and allows automatic or semi-automatic manipulation. Furthermore, the inventive method is intended to produce samples of as high quality and specificity as possible. The prior art contains no suggestions as to the use and overlaying of two images originating from two different image sources. The overlaying of the image of the surface of the preparation with the image of the section of the same preparation provides important information to support the selection of the desired punching positions. This produces punched-out samples of high quality and specificity. In contrast thereto, the methods in the prior art work merely with a surface image of an image source. A person skilled in the art would not arrive at a method as per claim 1 without thereby being inventive. The same applies to dependent claims 2-26.

3. A similar argument to that given in point 2 also applies to the device claimed in claims 27-41. The subject matter of claims 27-41 therefore does not involve an inventive step (PCT Article 33(3)).
4. The following points likewise have to be considered:

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- 4.1 Pursuant to PCT Rule 11.13(m), the same feature must be provided with the same reference sign throughout the application. This requirement has not been met by the use of reference sign 34. Reference sign 34 only appears in claim 29 and nowhere else in the application.
- 4.2 Pursuant to PCT Rule 11.13(m), the same feature must be provided with the same reference sign throughout the application. This requirement is not met by the use of reference signs (for the memory) 11 (page 11, line 27, claim 27 and figure 1) and 12 (claim 39).